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means, recorded on the recording medium, for printing said page number for each local hypertext link.

17. (original) A computer implemented method for identifying hypertext links in document printouts comprising the steps of:

scanning a document to be printed and identifying local hypertext links within the document,

computing and storing a page location of each identified local hypertext link within the document,

sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and

rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link.

REMARKS

Responsive to the Decision on Appeal, the Examiner has not restated the rejection of claims 1-3, 6, 10, 12-14 and 16 under 35 USC §103 as being unpatentable over Stork et al., U.S. patent 5,781,914 in view of Kogan et al., U.S. patent 5,809,317 as set forth in the Office Action made final and mailed September 10, 2002, the Examiner now rejects claims 1-3, 6, 10, 12-14 and 16-17 under 35 USC §102(e) as being anticipated by over Stork et al., U.S. patent 5,781,914. Claims 4, 5, and 8 stand rejected under 35 USC §103 as being unpatentable over Stork et al., U.S. patent 5,781,914 in view of publication Microsoft Word Tutorial "Microsoft Word Basic

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Features". Claims 7 and 9 stand rejected under 35 USC §103 as being unpatentable over Stork et al., U.S. patent 5,781,914 in view of publication Advanced Microsoft Word "Footnotes and Endnotes". The Notice of References Cited includes the same references as cited by the Examiner in the Office Action made final and mailed September 10, 2002. The Examiner indicates that claims 1, 10, and 13 are independent claim. Claim 17 also is an independent claim.

Applicants' attorney appreciates the time and courtesy shown during the telephone interview of April 6, 2005. During the telephone interview, the merits of invention and distinctions of the invention over the applied Stork et al., U.S. patent 5,781,914 under 35 USC §102(e) were discussed. Agreement was not reached during the telephone interview.

Reconsideration and allowance of each of the claims 1-10, 12-14 and 16-17, as presented herein, is respectfully requested.

Stork et al., U.S. patent 5,781,914 discloses a conversion method and apparatus that allows for converting a hardcopy document into a hyperdocument and vice versa. During hardcopy to hyperdocument conversion, hypertext information stored on the hardcopy document is used to set up links to other documents. During hyperdocument to hardcopy document conversion, hypertext link information is encoded and stored on the hardcopy document. A process is described where a hypertext document is converted into a plain paper document. One embodiment of this process is shown in FIG. 5. The hardcopy document that results contains hypertext link information in machine readable format to enable conversion back into a hypertext

document format. Thus, the link information will be available to the user to enable a reversal back into a hypertext document. Referring to FIG. 5, the conversion process begins by creating a bit map of a hyperpage that is currently displayed on the display screen from a screen "dump" (processing block 501). An example of such a document is shown in FIG. 6A. A portion of the bit map is shown in FIG. 6B. Once a bit map has been created, the hyperwords in the bit map are detected (processing block 502). In one embodiment, the hyperwords are detected by using a template. Such a template is shown in FIG. 6D. The bit map locating portions of the bit map are searched with the template, generating correlation values. FIG. 6E illustrates correlation values around the boxed region shown in FIG. 6C. The correlation value indicate whether there is a high correlation between portions of the document and the template. Once the marked words have been identified, the location and hyperlink information is encoded (processing block 503), the information is formatted into one or more pages (processing block 504), and a hardcopy document is printed having a sidechannel with encoded hyperlink information (processing block 505). In one embodiment, a template may be encoded as well for use in locating active regions.

The publication Microsoft Word Tutorial "Microsoft Word Basic Features" discloses a word processing program enabling text to be displayed in bold or superscript form.

The publication Advanced Microsoft Word "Footnotes and Endnotes" discloses a word processing program enabling text to be displayed in footnote form.

As discussed during the telephone interview, Applicants respectfully

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submit that the applied Stork et al., U.S. patent 5,781,914 (Stork) does not teach or provide any suggestion to enable identifying hypertext links in document printouts, as taught and claimed by Applicants.

Claims 1, 17, and 10 respectively recite computer implemented methods and apparatus for identifying hypertext links in document printouts. Claim 13 recites a computer program product for implementing document printing including identification of hypertext links. The present invention, as recited in each of the independent claims 1, 10, 13 and 17, enables identifying hypertext links in document printouts. The subject matter of the independent claims 1, 10, 13 and 17, is not shown nor suggested in the references of record. Stork does not enable identifying hypertext links in document printouts as taught and claimed by Applicants.

Each of the independent claims 1, 17 and 13 respective recite the step of or means, recorded on the recording medium, for sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link. Independent claims 1 and 13 further recite that the rendering step includes printing a corresponding uniform resource locator (URL) for each external hypertext link. The cited Stork et al. reference provides no suggestion or any means for or the step of checking printable objects to identify each printable object within a hypertext anchor tag. The cited Stork et al. reference provide no suggestion or any means for or the steps of rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link; nor any

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suggestion or any means for printing a corresponding uniform resource locator (URL) for each external hypertext link.

As discussed during the telephone interview, Stork teaches a hardcopy document that may be used to recreate a hypertext version of the document with the correct or same link information. Stork expressly teaches providing encoded machine-readable information 101 that may be located anywhere on the document where human-readable information is not obscured (This location is referred to as a side channel). Stork, Column 4, lines 56-59. (Emphasis added). Applicants respectfully submit that Stork fails to disclose, and provides no suggestion, of the recited claim limitation of rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link.

Applicants respectfully submit that there are significant differences between what is disclosed in the Stork et al. patent and the subject matter of the pending claims so that it is inappropriate for the Examiner to have rejected claims 1-3, 6, 10, 12-14 and 16-17 of the above-identified application under 35 U.S.C. §102 because "[i]t is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention" (Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986)). See also In re Bond, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) ("every element of the claimed invention must be identically shown in a single reference.").

Anticipation is a question of fact. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). The inquiry as to whether a reference anticipates a claim must

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focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations in the claim are found in the reference, or 'fully met' by it." Anticipation under § 102 can be found only when the reference discloses exactly what is claimed; where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account. Tyler Refrigeration v. Kysor Industrial Corp., 777 F.2d 687, 689, 227 U.S.P.Q. 845 846-47 (Fed. Cir. 1985)

Applicants respectfully submit that Stork does not enable, nor provide any suggestion of identifying hypertext links in document printouts including the step of rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link, as recited in independent claims 1 and 17. Stork does not enable, nor provide any suggestion of printing a corresponding uniform resource locator (URL) for each external hypertext link, as recited in independent claim 1. Stork does not enable, nor provide any suggestion of a printing program utilizing said stored document data for printing a document including a predefined indication of each hypertext link within the document to be printed including a corresponding uniform resource locator (URL) printed for each external hypertext link, as recited in independent claim 10. Stork does not enable, nor provide any suggestion of means, recorded on the recording medium, for rendering each identified printable object within

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said hypertext anchor tag with a predefined indication of the hypertext link including means, recorded on the recording medium, for printing a corresponding uniform resource locator (URL) for each external hypertext link, as recited in independent claim 13.

Thus, Applicants respectfully submit that the rejection of claims 1-3, 6, 10, 12-14 and 16-17 of the above-identified application under 35 U.S.C. §102 is incorrect and should be withdrawn. Applicants respectfully submit that the present application is in condition for allowance, and should be allowed, and each of the pending claims 1-10, 12-14 and 16-17 should be allowed.

Only Applicants teach a computer implemented method and apparatus for identifying hypertext links in document printouts including the above limitations of claims 1, 10, 13 and 17 or as further defined in claims 1 and 13. Apparatus for identifying hypertext links in document printouts as recited by independent claim 10 is not shown nor suggested by the total teachings of the cited Stork et al. The total teaching of the cited Stork patent does not achieve the claimed invention. Stork et al. teach the use of encoded, machine-readable information to enable hypertext documents to be created automatically, without user interaction. The publications Microsoft Word Tutorial "Microsoft Word Basic Features" and Advanced Microsoft Word "Footnotes and Endnotes" add nothing to suggest the invention of claims 1, 10, 13, and 17. Thus, each of the independent claims 1, 10, 13, and 17 is patentable.

Applicants have reviewed all the art of record, and respectfully submit that the claimed invention is patentable over all the art of record, including the references

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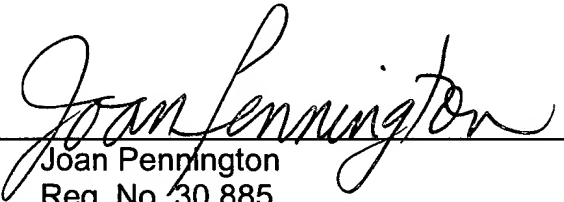
not relied upon by the Examiner for the rejection of the pending claims.

Each of the dependent claims 2-9, 12, 14, and 16 is patentable for the same reasons as independent claims 1, 10, 13, and 17. Dependent claims 2-9, 12, 14, and 16 further define the invention of patentable claims 1, 10 and 13 and are likewise patentable.

It is believed that the present application is now in condition for allowance and allowance of each of the pending claims 1-10, 12-14 and 16-17, is respectfully requested. Prompt and favorable reconsideration is respectfully requested.

If the Examiner upon considering this amendment should find that a telephone interview would be helpful in expediting allowance of the present application, the Examiner is respectfully urged to call the applicants' attorney at the number listed below.

Respectfully submitted,

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